REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. Claims 1, 6, 11, 16, 21, and 22 have been amended. Currently, claims 1-9, 11-19, 21, and 22 are pending in the present application of which claims 1, 6, 11, 16, 21, and 22 are independent. No new matter has been added.

Claims 1, 5-6, 11, 15, 16, 21, and 22 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Imagawa et al. (U.S. Patent Number 6,353,764). Claims 2, 7, 12, and 17 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imagawa et al. in view of DeVito (U.S. Patent Application Number 2001/0056225). Claims 3, 8, 13, and 18 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imagawa et al. in view of DeVito and further in view of Pijnenburg et al. (U.S. Patent Number 6,169,842). Claims 4, 9, 14, and 19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imagawa et al. in view of Kimoto et al. (U.S. Patent Number 6,054,981). The above rejections are respectfully traversed for at least the reasons set forth below.

Claim Rejection Under 35 U.S.C. §102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485

(Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

Claims 1, 5-6, 11, 15, 16, 21, and 22 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Imagawa et al. This rejection is respectfully traversed because the claimed invention as set forth in amended claims 1, 6, 11, 16, 21, and 22 and the claims that depend therefrom are patentably distinguishable over Imagawa et al.

Imagawa et al. discloses a system for monitoring a user's gesture for controlling a device. The monitoring section continuously monitors people's attributes and their peripheral environment. The people's attributes include people's positions, postures, faces, expressions, eyes or head direction, motions, voices, physiological conditions, identities, forms, weights, sexes, ages, physical and mental handicaps, and belongings. The camera can be used to monitor people's positions, postures, faces, expressions, motions, forms, and belongings in a non-contact manner. This monitored information is then used to control a device.

According to an embodiment of the invention, a method and apparatus are shown for monitoring user activity and automatically controlling a media player in response to predefined events. The disclosed media player controller includes one or more audio/visual capture devices

focused on one or more users. The obtained audio and video information is processed by the media player controller to identify one or more predefined events.

Claims 1, 6, 11, 16, 21, and 22, as amended, recite analyzing additional information external to a user "wherein the additional information external to said user includes a feature of media" on the device or media player. Imagawa et al. fails to teach the analysis of information external to a user which includes a feature of media on a device or media player as recited in claims 1, 6, 11, 16, 21, and 22. As discussed above, Imagawa et al. discloses a gesture based control system. However, Imagawa et al. does not base decisions on any feature of the media of device being controlled. For example, Imagawa et al. will accept gesture to adjust the device but will NOT determine which song or artist is being played in order to use that information in a decision making process. Therefore, Imagawa et al. fails teach the analysis of a feature of media.

Accordingly, Imagawa et al. fails to teach all of the features contained in claims 1, 6, 11, 16, 21, and 22, and thus, these claims are believed to be allowable. Claim 5 depends upon allowable claim 1 and claim 15 depends upon allowable claim 6. It is submitted that these dependent claims are also allowable at least by virtue of their dependencies.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or

> to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 2, 7, 12, and 17 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imagawa et al. in view of DeVito. The Applicants submit that claims 1, 6, 11, and 16 are not anticipated by Imagawa et al. In addition, the Official Action does not rely upon DeVito to make up for the deficiencies in Imagawa et al. with respect to claims 1, 6, 11, and 16. Therefore, claims 2, 7, 12, and 17 which depend from claims 1, 6, 11, and 16, respectively, are allowable at least by virtue of their dependencies. The Examiner is therefore respectfully requested to withdraw the rejection of claims 2, 7, 12, and 17.

Claims 3, 8, 13, and 18 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imagawa et al. in view of DeVito and further in view of Pijnenburg et al. The Applicants submit that claims 1, 6, 11, and 16 are not anticipated by Imagawa et al. In addition, the Official Action does not rely upon DeVito or Pijnenburg et al. to make up for the deficiencies in Imagawa et al. with respect to claims 1, 6, 11, and 16. Therefore, claims 3, 8, 13, and 18 which depend from claims 1, 6, 11, and 16, respectively, are allowable at least by virtue of their

dependencies. The Examiner is therefore respectfully requested to withdraw the rejection of claims 3, 8, 13, and 18.

Claims 4, 9, 14, and 19 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Imagawa et al. in view of Kimoto et al. The Applicants submit that claims 1, 6, 11, and 16 are not anticipated by Imagawa et al. In addition, the Official Action does not rely upon Kimoto et al. to make up for the deficiencies in Imagawa et al. with respect to claims 1, 6, 11, and 16. Therefore, claims 4, 9, 14, and 19 which depend from claims 1, 6, 11, and 16, respectively, are allowable at least by virtue of their dependencies. The Examiner is therefore respectfully requested to withdraw the rejection of claims 4, 9, 14, and 19.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

While we believe that the instant amendment places the application in condition for allowance, should the Examiner have any further comments or suggestions, it is respectfully requested that the Examiner telephone the undersigned attorney in order to expeditiously resolve any outstanding issues.

Application No: 09/821,183
Attorney's Docket No: US 010105

In the event that the fees submitted prove to be insufficient in connection with the filing of this paper, please charge our Deposit Account Number 50-0578 and please credit any excess fees to such Deposit Account.

Respectfully submitted,
KRAMER & AMADO, P.C.

Terry W. Kramer

Terry W. Kramer
Registration No.: 41,541

KRAMER & AMADO, P.C.
1725 Duke Street, Suite 240
Alexandria, VA 22314
Phone: 703-519-9801
Fax: 703-519-9802

Date: January 23, 2006